

RESPONSE under 37 C.F.R. § 1.111  
U.S. Appl. No. 10/026,397

**REMARKS:**

By this amendment, Applicant cancels claims 3-4, 7 and 15 thus claims 1-2, 5-6, 8-14 and 16-19 are all the claims pending in the present application. All claims stand rejected and claims 12, 13 and 15 were objected to by the Examiner. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and remarks that follow.

**OBJECTIONS.**

**ABSTRACT**

The Office Action objects to the Abstract and requests correction. By this amendment, Applicant addresses this objection; reconsideration is respectfully requested.

**SPECIFICATION**

The Office Action objects to the specification under 37 C.F.R. § 1.75(d)(1) as not providing proper antecedent basis for claims 4, 7 and 8. Applicant disagrees and respectfully notes that MPEP 608.01(o) is not applicable as these claims as these claims form part of the original specification, as opposed to being amended or added claims. Claims 4 and 7 are cancelled now but it is respectfully submitted that each limitation in these claims have/had express support in the detailed description section. (See specification pg. 12, ll. 21-22; ll. 1-5; and ll. 13-18). Accordingly, reconsideration is respectfully requested.

**DRAWINGS**

The drawings are objected to as (1) not being in a form acceptable for examination and (2) failing to show "how" to perform method steps recited in the claims. In respect to item (1), Applicant submits herewith, Replacement sheets 1 and 2 in formal format. Replacement sheets 1 and 2 do not include any substantive changes or new matter.

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In respect to item (2) Applicant respectfully disagrees with the Examiner, the "structural detail" for performing the claimed methods is readily shown in, at least Fig. 2. For example, a computing device 50 including a classmark 200 which may be updated via, for example, a service discovery module 210, user preference module 230, logic services module 250, physical services module 240 and/or load system load monitor 260. Fig. 2 also shows one or more applications 270 which may be adjust performance based on classmark 200. Fig. 1 shows exemplary hardware implementations for these modules, monitors or applications. Accordingly, it is submitted that the drawings fully comply with the requirements of 37 C.F.R. § 1.83(a) and reconsideration of this objection is respectfully requested. Notwithstanding, should Examiner have a viable suggestion or recommendation for improving the application's showing "how" to dynamically update a client classmark in a static drawing, Applicant is amenable to such suggestions.

#### CLAIMS

1. The Office Action objects to claims 13 and 15 alleging informalities. By this amendment, Applicant believes these issues have been addressed and reconsideration is respectfully requested.

#### CLAIM REJECTIONS.

##### 35 U.S.C. § 112 (2<sup>nd</sup>)

Claims 7 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action alleges the terms "physical capabilities" and/or "logical capabilities" recited in these claims are not defined "within the claim language." Applicant respectfully traverses these rejections for the following reasons.

Page 12, lines 2-20 of the instant specification describes embodiments in which a physical service module 240 may update classmark 200 regarding the status or availability of hardware components within the portable communication device 50 and/or a logical services

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module 250 that may update classmark 200 regarding status of availability of various logical services (e.g., virtual machine capabilities, synchronization, translators, mails services) which provide logical capabilities of the portable device 50 and which may be used by applications executing within the portable computing device 50 to select what logical services should be used during execution of those applications. Accordingly, one of ordinary skill in the art, when reading the language of claims 7 and 8 in light of the specification (35 U.S.C. § 112) would readily understand the subject matter of these claims. In support of Applicant's position, Applicant notes that the Examiner apparently understands the meaning of these terms as demonstrated in the observations at the end of the respective rejections. While claim 7 is now cancelled, Applicant respectfully submits this claim language meet all requirements of 35 U.S.C. § 112 and requests the Examiner to reconsider and withdraw any rejections in this regard.

35 U.S.C. § 102

Claims 1-2, 5-6 and 11 are rejected under 35 U.S.C. § 102(e) [*sic* (b)] as being anticipated by U.S. Patent 6,002,936 to Roel-Ng et al. (hereinafter "Roel-Ng"). Applicant respectfully traverses this rejection for the following reasons.

Applicant respectfully points out that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

In the instant case, Roel-Ng discloses a telecommunications system for determining the position of a mobile station (MS) using the optimal method for positioning. (Abstract). Roel-Ng discloses that in existing GSM systems, classmarks may be sent by a MS to a mobile switching center (MSC) when the MS registers with the MSC to provide information to the MSC about the MS. Roel-Ng simply proposes to include in the existing GSM classmark system, the MS capabilities in regard to positioning (e.g., what type of methods the MS can use for position

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location determinations). Roel-Ng does not however disclose or suggest in any manner, dynamically generating a client classmark as the mobile computing device is moved as recited in Applicant's independent claim 1 or maintaining a client classmark for a device based upon what communication services are available as recited in Applicant's independent claim 6). In fact, Roel-Ng does not disclose either way whether the classmark is static or dynamic but since the positioning methods capabilities of an MS will never change (i.e., its positioning capabilities are fixed), there appears to be no reason why one would dynamically update the Roel-Ng classmark.

Because Roel-Ng fails to teach or suggest dynamic generation of a client classmark or a client classmark that is maintained based upon what communication services are available, Roel-Ng cannot anticipate Applicant's independent claims 1 and 6, or the claims which depend there from. Accordingly, reconsideration and withdrawal of the 102 rejection are respectfully requested.

35 U.S.C. § 103(a)

Claims 3-4, 7-10, 12-13 and 15-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Roel-Ng in view of U.S. Patent 6,480,966 to Rawson III or in view of European Patent Application EP 0980190 to Koehne et al. (hereinafter "Koehne") or Koehne in view of Rawson III. Applicant respectfully traverses these rejections for the following reasons.

It is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

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Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In both of these rejections, the Office Action relies on Roel-Ng to disclose dynamically generating the client classmark and, as discussed above in regard to the 102 rejection, Roel-Ng fails to teach or suggest this feature of Applicant's claim 1.

Rawson III is dedicated to methods for interaction between lead and slave processors and thus also fails to teach or suggest dynamically generating a client classmark or maintaining a client classmark based on what communication services are available. Thus even when combining Roel-Ng with Rawson III, the limitations of Applicant's independent claims are not disclosed or suggested.

Koehne on the other hand, discloses a telecommunication device which stores information about supported modes, bands and/or subscriber specific networks which is compared with information received about currently available networks. Applicant believes that Koehne does not disclose a client classmark as recited in Applicant's claims. Notwithstanding, Applicant amends the foregoing claims to better clarify embodiments of the present invention. In this respect, Applicant submits that none of the cited art of record discloses or suggests a client classmark which is updated to include information about hardware capabilities or load of the processor as recited in Applicant's amended claims.

Accordingly, even assuming it would be proper to combine the teachings of the cited references as alleged in the Office Action, and Applicant respectfully submits it is not, Roel-Ng.

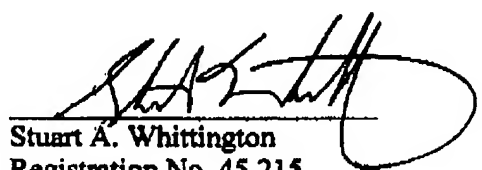
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Rawson III and Koehne, taken alone or in combination, fails to teach or suggest the limitations of Applicant's claims. Accordingly, reconsideration and withdrawal of all 103 rejections of record are respectfully requested.

**CONCLUSION.**

In view of the above, reconsideration and allowance of this application is now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to Deposit Account # 50-0221.

Respectfully submitted,



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